

Application Serial No. 10/601,946
Response To Office Action dated September 16, 2005
In response to Office Action mailed July 12, 2005

REMARKS

I. IN THE OFFICE ACTION

In the Office Action, the Examiner allowed claims 1, 3-12, 14, 15, and 17-20. However, as discussed in greater detail below, the Examiner rejected claims 21-31.

With respect to the reasons for rejection of claims 21, 25, 29, and 31, the Examiner rejected those claims under the provisions of 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,974,875 issued to Herd et al. (“Herd”). The Examiner alleges that Herd discloses in figure 9 a pressure line breechblock-coupling member with a releasably connected female end 351 (“251” in specification) and a male end 301 in fluid communication with riser equipment 212 and the pressure line diameter greater than two inches (col. 3, line 47). Office Action, page 2.

The Examiner rejected claim 30 under the provisions of 35 U.S.C. § 103(a) as allegedly being obvious over Herd. The Examiner states that Herd discloses a pressure line breechblock-coupling member with releasably connected female end 351 and male end 301 in fluid communication with riser equipment 212 but not end 301 as female and end 351 end as male. Office Action, page 3. The Examiner then takes “Official Notice” that it is “well known to make connections with male and female arrangements, and to make either connection member a male or female element.” *Id.* Accordingly, the Examiner concludes that “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to construct the connection with male end 351 and female end 301 since it is well known to do so.” *Id.*

Application Serial No. 10/601,946
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The Examiner rejected claims 22-24 and 26-28 under the provisions of 35 U.S.C. § 103(a) as allegedly being obvious over Herd in view of U.S. Patent No. 6,530,430 issued to Reynolds (“Reynolds”). The Examiner states that Herd discloses a pressure line breech block coupling member with a releasably connected female end 351 and a male end 301 in fluid communication with riser equipment 212 but not a tensioner, slip-join assembly, or slip-joint tensioner. Office Action, page 3. The Examiner then states that “Reynolds presents a tensioner 70, slip-joint assembly 90, or slip-joint tensioner 30 associated with a blowout preventer.” *Id.* The Examiner then concludes that “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the Herd et al. connection in the Reynolds system as indicated by applicant at page 18, lines 6-7 of the specification. Office Action, pages 4.

II. DISCUSSION OF REJECTIONS/OBJECTIONS

A. Claim Rejections – Claims 21-31

1. Claim Rejections - 35 U.S.C. § 102(b)

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Moreover, it is not enough that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Id.*; *Lindemann Maschienenfabrik GmbH v. American*

Application Serial No. 10/601,946
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Hoist & Derrick Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984) (emphasis added). Further, under 35 U.S.C. § 102, anticipation requires that the prior art reference “must be enabling, thus placing the allegedly disclosed matter in the possession of the public.” *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986). In this regard, the Federal Circuit has stated that “[a]n anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545 (Fed. Cir. 1998).

Applicant respectfully submits that claims 21, 25, 29 and 31 are not anticipated by Herd. Herd discloses and teaches breechblock connections used to connect one or more of riser, casing, casing head, and hanger head with one another. See e.g., Col. 3, line 54 - Col. 4, line 19; Col. 4, lines 27-32; Col. 7, lines 35-37; Col. 8, lines 56-67. Herd is not directed to pressurized line systems, such as choke and kill lines, or to riser equipment.

On the other hand, claims 21, 25, 29 and 31 are directed to “pressure lines” and “riser equipment.” At page 2, Applicant expressly discusses “equipment” as having “pressure conduits, or pressure lines, to supply pressure through the lumen of the pressure lines to the equipment in order for the equipment to control and operate valves and other mechanical components of the equipment.” Specification, page 2, lines 8-14. The Applicant then states that “[t]hese pressure activated pieces of equipment are referred to herein as ‘riser equipment.’ Examples of riser equipment include tensioners, slip-joint assemblies, and slip-joint tensioner assemblies.” Specification, page 2, lines 12-14.

Application Serial No. 10/601,946
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The riser, casing, casing head, and hanger head disclosed and taught in Herd are not equipment that requires pressure to operate. Nor are the riser, casing, casing head, and hanger head supplying pressure to operate any equipment. Instead, additional “pressure control equipment” such as “blowout prevention equipment” connected to or disposed within riser or casing provide such pressure (see Col. 6, lines 1-11), and any “tool” connected to the riser or casing is connected through “threads” (see Col. 6, lines 31-36). Herd, therefore, does not disclose, teach, or suggest the riser, casing, casing head, and hanger head as the source of the pressure or as providing a breechblock connection between the riser, casing, casing head, and hanger head and riser equipment.

Due to the fact that claims 21, 25, 29 and 31 are all directed to “riser equipment” and to “pressure lines,” Applicant respectfully submits that claims 21, 25, 29 and 31 are not anticipated, or rendered obvious by Herd. Accordingly, Applicant respectfully submits that Herd does not disclose each limitation recited in independent claims 21 and 25 (or dependent claims 29 and 31 which depend from claim 25) and that because independent claims 21 and 25 are not rendered unpatentable by Herd, none of the claims depending from claims 21 and 25, i.e., claims 22-24 and 26-31, are rendered unpatentable. As such, Applicant respectfully requests that the rejection of claims 21-31 under the provisions of 35 U.S.C. § 102(b) be withdrawn.

2. Claim Rejections - 35 U.S.C. § 103(a)

Identification in the prior art of each individual part claimed in a patent is insufficient to defeat patentability of the whole claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); *In re Rouffett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Rather, to establish obviousness based

Application Serial No. 10/601,946
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on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by applicant. *In re Kotzab*, 217 F.3d at 1370. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *Id.* The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *Id.* In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *Id.* The test for an implicitly showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *Id.* Whether the Board of Patent Appeals and Interferences relies upon an express or an implicit showing, it must provide particular findings related thereto. *Id.* Broad conclusory statements standing alone are not “evidence.” *Id.* (quotes in the original).

Claim 30 has been found by the Examiner to be “obvious” over Herd. However, claim 30 depends from independent claim 25. As shown above, independent claim 25 is patentable over Herd. As such, claim 30 is not rendered obvious, but instead is patentable, over Herd. Thus, Applicant respectfully requests that the rejection of claim 30 under the provisions of 35 U.S.C. § 103(a) be withdrawn.

Claims 22-24 and 26-28 have been found by the Examiner to be “obvious” over Herd in view of Reynolds. In making the finding of obviousness the Examiner uses the specification of the

Application Serial No. 10/601,946
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present application as the basis to conclude that it would be obvious to use the connections disclosed in the present application with the tensioner, slip-joint assembly, and slip-joint tensioner assembly disclosed in Reynolds. The Examiner's reliance upon the specification of the present application, however, is misplaced. U.S. patent law is clear in holding that the disclosure of the pending patent application cannot form the basis for concluding that references are combinable and, thus, the claims are obvious. *See In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988) (both suggestion and reasonable expectation of success must be found in the prior art, and not in the applicant's disclosure); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984) (patent cannot be the source for teaching or suggestion the combination of prior art). Therefore, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness and that claims 22-24 and 26-28 are not rendered obvious over Herd in view of Reynolds. As such, Applicant respectfully requests that the rejection of claims 22-24 and 26-28 as being obvious under the provisions of 35 U.S.C. § 103(a) be withdrawn.

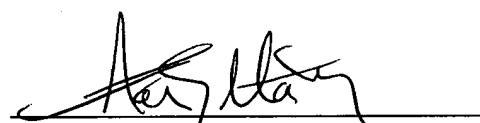
Application Serial No. 10/601,946
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CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests that the rejections of claims 21-31 be withdrawn and a timely notice of allowance of claims 1, 3-12, 14, 15, and 17-31 be issued. In order to expedite the examination of this application, Applicant requests the Examiner to contact the undersigned at (713) 220-4168 to discuss any matters that can be resolved by telephone.

Respectfully submitted,

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